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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,822	09/30/2004	Hubert Elmer	5255-32PUS	2261

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COHEN, PONTANI, LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

EXAMINER

CHAPMAN, JEANETTE E

ART UNIT	PAPER NUMBER
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3633

MAIL DATE	DELIVERY MODE
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04/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,822

Applicant(s)

ELMER, HUBERT

Examiner

Jeanette E. Chapman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14, 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-14, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT WO 94/27019 in view of DE 3425765 and Holmes (4912898)

PCT 27019 discloses a glass separating wall comprising :

- A pair of frameless side panels 3,5 mounted between a top structure and a base
- A frameless transom panel 8 between the side panels 2,5; the transom panel 8 being held by the side panels 3,5 and the top structure
- A rotatable door leaf 4 between the side panels and below the transom panel 8
- The door leaf 4 being rotatably supported exclusively by the transom panel, at the hinge 9, and at the base by the hinge 2
- The fittings inherently comprising complementary first and second fitting parts secured to the door leaf and then to the transom
- The first and second fittings 2,9 cooperating to permit rotation

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- The side panels 3,5 and the transom panel 8 are fastened to one another by and to the top structure and the base without the fitting which support the door leaf
- The side panels, the transom and the door leaf have a uniform grid dimension and are arranged in a common plane as shown in figure 1
- The side panels and the transom panel each have longitudinal abutting edges; the abutting edges of the transom panels being connected to the abutting edges of the side panel; see figure 1

DE '765 discloses a glass separating wall with a side panel 28, a transom 26, and a door leaf. The wall further comprises:

- The door leaf 2 being rotatably supported exclusively by the transom panel, at the hinge 22, and at the base by the hinge 6
- The fittings inherently comprising complementary first and second fitting parts secured to the door leaf and then to the transom
- The first and second fittings cooperating to permit rotation
- The side panels 28 and the transom panel 26 are fastened to one another by and to the top structure and the base without the fitting which support the door leaf
- The first and second fitting part comprises pins 14 and 22 and the other of the fitting comprise a bearing brush which receives the pin; see figure 1

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In view of the above it would have been obvious to one of ordinary skill in the art to modify PCT '019 to include the pin and bearing fitting of DE -765 to keep with the minimalist structure of the wall as shown by DE.

PCT also lacks the permanently elastic mass between the transom panel and the side panels and the transom panel being connected in frictional engagement with the side panels by the permanently elastic mass. Holmes discloses glass panels with permanently elastic mass 53/59 between the transom panel 95/96 and the side panels 13/95 and the transom panel being connected in frictional engagement with the side panels by the permanently elastic mass 53/58. See figures 12 and 13. The elastic mass is made of silicon.

It would have been obvious to one of ordinary skill in the art to set the side panels and the transom using the silicone in order to provide a reflective glazing compound to produce a continuous, smooth, reflective surface with appropriate exterior glass sheets.

Oscari, figures 1 and 8, discloses the glass separating wall including frameless side panels, a transom panel and a door leaf. Oscari includes a top and bottom structure 11,12. Each of the top and bottom structure includes a channel and the side panels engaging the channels. The side panels being connected in frictional engagement with the top and the base by permanent elastic mass 17. See figures 18-19 and column 3, lines 40-42. If the elastic mass 17 engages the panels, then the elastic mass between the side panels and the transom, taught by Holmes, would also inherently be engaged by element 17 also to provide a flat surface across the glazing system. Oscari also

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discloses the side and transom panels fastened to one another and the base independently from fitting which support the rotatable door. See figures 1, 8 and 9.

In view of the above, it would have been obvious to one of ordinary skill in the art to modify the base reference to include the top and base structure engaging channels and the separate engaging structures for the door leaf, side panels and transom panels in order to provide a unitary but strong structure.

PCT '019 lacks the vertically oriented stiffening elements supported on the base and arranged against the side parts perpendicular to the side parts. Oscari discloses a frameless glazing system with leaves and fixing. Oscari also discloses the vertically oriented stiffening elements 60 supported on the base and arranged against the side parts perpendicular to the side parts. It would have been obvious to one of ordinary skill in the art to include these stiffening elements to strengthen the structural integrity of the glazing elements as shown by Oscari.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over PCT WO 94/27019 in view of DE 3425765, Oscari and Holmes (4912898) and further in view of JP 2003268907A. PCT '019 lacks the transom panel fastened to the side panels and top structure only by the elastic mass. JP 907 discloses glazing panels 10 secured to each other 100 and the other structure 12 only by elastic mass 30. It would have been obvious to one of ordinary skill in the art to modify PCT '019 to include the above recited method of securement in order to improve the fireproofing properties, to facilitate assembly and to improve the external appearance of the glass panels assembly.

Response to Arguments

Applicant's arguments filed 12/26/07 have been fully considered but they are not persuasive. Applicant argues that there is no motivation for combining the above references. Motivation has been given in the rejections above. Further applicant is taking well known elements and structures and putting them together and terming the same unobvious. For example the upper and lower channels are well known in the art of building facades and exterior surface such as curtain walls and glass panel walls. Many of the structural elements are applied to the base reference to make the same more of a cohesive unit.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all of the

references are concerned with the structures of glass panel walls and glass panel structures and obvious variants thereof.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeanette E. Chapman whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6 843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeanette E Chapman/
Primary Examiner, Art Unit 3633
